

**REMARKS****Prior Art Rejections**

In the Office Action mailed on July 16, 2007, the Examiner rejected the pending independent claim (claim 39) as being anticipated by Norris (US 2003/0072013 A1), stating that Norris contained all of the elements of this independent claim. It should be noted, however, that Norris describes a printer that can receive audio information, but then uses a speech recognition software module to convert that audio information into text that is printed as characters. This is not a feature of the present Lexmark invention, and claim 39 has been amended to emphasize that aspect.

This amendment by itself should make claim 39 patentably distinct from Norris. However, the Examiner cited other prior art references that could potentially be used in an obviousness rejection for claim 39, so claim 39 has also been amended to account for those references. More specifically, some of the dependent claims were rejected in view of Morohashi (US 6,043,899), which discloses a printing system that uses a microphone to accept audio information, and then stores that information in "dot code data blocks" and prints those dot code data blocks onto a print medium that is "tape like." (See column 5, lines 35-37 of Morohashi.) This tape-like print media is some type of continuous piece of media (e.g., paper) that must be cut periodically, or the tape would become essentially "infinite" in length, and therefore difficult to handle. To solve this problem, Morohashi includes a print medium cutter lever 8 for cutting the print media at a desired position (see column 5, lines 56, 59). This is quite different from the present Lexmark invention, which uses standard sheets of print media, such as letter-sized paper or transparencies. This aspect of the present Lexmark invention has been emphasized in the amendment to claim 39.

Another prior art reference cited by the Examiner is Soscia (US 6,441,921 B1), which discloses a method for imprinting and reading a sound message on a greeting card. Soscia uses a microphone to receive audio information, and uses an optical scanner to receive a photographic image that can be placed on the greeting card. The audio information is also placed on the greeting card by the printer, and in Soscia, the audio information is printed using ink that is

visible in infrared wavelengths. This information is printed directly over the "normal" image on the print media (which is to be a greeting card image of "regular" visible colors), however, the infrared wavelengths are almost invisible to the human naked eye, and the printed audio information thereby does not detract much from the "regular" image that is to be seen by the human user. A special lens assembly 66 and a two-dimensional image sensor 68 are used to scan the card for playing back the audio information. This lens assembly/image scanner is to be portable, much like a flashlight. (See column 6, lines 52-60, and column 7, lines 23-26.) The present Lexmark invention is not specifically designed with the purpose of printing directly on an image that is to be viewed by a human user, and instead reserves empty spaces on the print media for the audio information. This is disclosed in the figures, including FIG. 8, FIG. 10, and FIG. 11. In addition, claim 39 has been amended to emphasize this aspect of the present Lexmark invention.

In view of the amendments to claim 39, Applicant respectfully submits that this claim is now in condition for allowance with respect to the cited prior art.

#### ***Claim 45***

Claim 45 has been amended so as to be placed into independent form. Claim 45 was based on claim 39, and adds an optical scanner that generates a third data signal from scanning a sheet of hard-copy media in which at least a portion of the image information on that hard-copy media comprises audio information. This is in addition to the audio information that was received from the microphone.

Claim 45 was rejected in view of Norris, Morohashi, and Soscia, but mainly Soscia since the Examiner cited Soscia for having the capability for scanning a sheet of hard-copy media in which at least a portion of the image information comprises audio information. According to the Examiner, this feature of Soscia is found in column 2, lines 39-42 and in column 3, lines 11-15. It should be noted, however, that this portion of Soscia is where the information is played back for the human user. In other words, the greeting card has already been printed with both a viewable image, and also with audio encoded information that is printed right on the viewable image. The audio information of this greeting card must be played back somehow, and

this is where a reader is used which has the lens assembly 66 along with the two-dimensional sensor 68 to read the audio data. This is not a situation where microphone-generated audio information and image information from a hard-copy media that also includes some audio information are both combined and printed on a print media, as recited in claim 45.

While the Examiner is correct that Soscia has a method and apparatus for reading back or "playing back" audio information and originally printing that audio information on a greeting card, Soscia does not provide that audio information from a previous hard-copy printout. Instead, Soscia uses a scanner to read in the "regular" image data that is to be viewed on the greeting card by the recipient of that greeting card. And this image data input by that scanner is not audio information from that scanner.

None of the cited prior art references disclose a system in which audio information is received both from a microphone and from an optical scanner that scans a sheet of hard-copy media. Accordingly, Applicant respectfully submits that claim 45 is not rendered obvious in view of the cited prior art references.

#### ***Claim 46***

Claim 46 has been rejected as being obvious in view of Norris and Morohashi. Claim 46 has been placed into independent form, but in addition, claim 46 has had a new element added by which the print engine applies printing material to sheets of print media that are pre-cut to a predetermined size and fed into the print engine as needed upon the occurrence of a print job. This is quite different than Morohashi, which uses a continuous tape-like print medium, and has a cutter that can be used to cut the print medium into whatever lengths are desired by the user. In such a system, it is easy to "append" additional audio information, since it can be merely added at the end of the tape.

The present Lexmark invention is quite different because the sheets of print media are "standard" pre-cut sheets, such as letter sized 8½ by 11 sheets of paper or transparencies. One cannot simply add additional audio information on such a "standard" sheet of print media without being concerned about how much area (on the print media sheet) might still be available for receiving that additional (appended) audio information. In addition, claim 46 is for a

situation in which a user has previously added audio information and transferred that onto the hard-copy printout. Later, the user causes additional audio information to be sent to the microphone and converted into a further portion of the hard-copy printout as further audio information. This would likely require either the original hard-copy printout to be re-inserted to the printer so that the appended information could be placed in a new area on that hard-copy printout sheet of print media, or the entire print job would be printed again, this time including both the original set of audio information from the microphone and the additional (or appended) set of audio information from the microphone. The Morohashi patent does not cover these situations. Therefore, Applicant respectfully submits that amended claim 46 is in condition for allowance.

#### New Claims

A few new claims have been added by this Amendment. Claims 70-72 are based on claim 45, which is now in independent form. Claims 73-77 are based on claim 46, which is now in independent form. These claims are similar to claims 40-44, and no new subject matter is involved.

#### Conclusion

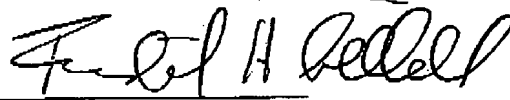
Applicant has amended claim 39, which was the only independent claim previously pending in this instant application. Applicant has also provided arguments as to why claim 39 should now be allowable. Applicant has converted two previously dependent claims into independent claims and has provided arguments as to why those claims should now be in condition for allowance.

There should be no fees associated with this amendment. (There are 17 total claims, and 3 independent claims.) However, the Director of Patents and Trademarks is hereby authorized to charge any underpayment of fees incurred due to this amendment to Deposit Account No. 12-1213 (for Lexmark International, Inc.)

Applicant respectfully requests the Examiner to favorably reconsider and allow all of the

pending claims.

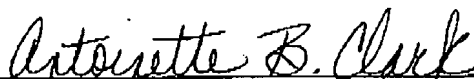
Respectfully submitted,  
MARK JOSEPH EDWARDS

By   
Frederick H. Gribbell  
Attorney for Applicant  
Registration No. 33,892

TAYLOR & AUST, P.C.  
10250 Alliance Road, Suite 120  
Cincinnati, Ohio 45242  
(513) 891-2100

**CERTIFICATE OF TRANSMISSION BY FACSIMILE**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office at FAX No. (571) 273-8300, on this 12th day of October, 2007.



\\pattmnd\lex570.amd.doc

Serial No.: 10/619,239

-11-

Attorney Docket: 2001-0941.01